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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,526	03/06/2002	Tomoka Morita	P22007	4567
7055	7590	03/17/2006	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			NGUYEN, JIMMY H	
			ART UNIT	PAPER NUMBER
			2673	

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/069,526

Applicant(s)

MORITA ET AL.

Examiner

Jimmy H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22, 24-31 and 33-39 is/are pending in the application.
- 4a) Of the above claim(s) 24, 26-30, 33 and 35-39 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-21 is/are allowed.
- 6) ☒ Claim(s) 22, 25, 31 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This Office Action is made in response to applicant's amendment filed on 12/21/2005. Claims 1-22, 24-31, and 33-39 are currently pending in the application. An action follows below:
2. Claims 24, 26-30, 33 and 35-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species II-VI. Claims 1-22, 25, 31, and 34 are considered.

### ***Notice to Applicants***

3. It is noted to Applicants that claims 24, 28, 29, 33, 37 and 38 should be cancelled because they depend upon either the cancelled claim 23 or the cancelled claim 32.

### ***Information Disclosure Statement***

4. All the documents in the information disclosure statement (IDS) submitted on 12/21/2005 are crossed out because they were previously submitted and considered by the examiner. Further, in response to Applicants' argument with respect to the IDS, see pages 32-33 of the amendment filed on 12/21/2005, examiner directs the applicants to a copy of IDS attached in the Office Action dated 09/21/2005, which shows that in the "Foreign Patent Documents" section, a column of "Translation" is provided to indicate the corresponding English translation attached, e.g., in the instant application, examiner had noticed the corresponding English Abstract considered. Further, it is noted to Applicants that the English translation of foreign patent document should not be listed in the "Other Documents" section. If the applicants still don't know where to list the document, please consult with your attorney and if your attorney doesn't even know where to list the document, please feel free to call USPTO customer service or the examiner.

### ***Drawings***

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5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature, “said N sub-fields SF1, SF2, ..., SFN have equal weights in this order” of claim 22 (see lines 9-10) and claim 31 (see lines 9-10), must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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7. Claims 22, 25, 31, and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claims above, these claims contain the feature, “said N sub-fields SF1, SF2, ..., SFN have equal weights in this order” (see lines 6-8 of claims 22 and 31), which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure, when filed, specifically figs. 4-8 and 12-26, expressly discloses sub-fields SF1, SF2, ..., SFN having weights of 1, 3, 6, 12, ..., in the order, (see figs. 4-8), i.e., sub-fields SF1, SF2, ..., SFN having **greater** weights in the order from SF1 to SFN, e.g., Fig. 4 shows a sub-field SF1 having a weight of 1, a sub-field SF2 having a weight of 3, a sub-field SF3 having a weight of 6, and so on. Furthermore, it would have been obvious to one skilled in the art to recognize that the subfield SF1 corresponds to a lower order bit and the subfield SF2 corresponds to a higher order bit, then how the subfield SF2 has equal weight as that of the subfield SF1. Accordingly, these claims contain the above underlined feature which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

***Allowable Subject Matter***

8. Claims 1-21 are allowed. See the statement of reasons for the indication of allowable subject matter in the Office Action dated 9/21/2005.

***Response to Arguments***

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9. Applicants' arguments with respect to the drawing objection, the rejection under 35 USC 112, first paragraph, and the rejections under 35 USC 102(e) in the Office Action dated 9/21/2005, have been considered but are moot in view of the new drawing objection and the new ground(s) of rejections above.

10. With respect to Applicants' request for an acceptance of the drawings, see page 32 of the amendment, Examiner will confirm when the application is in condition for allowance because the drawings may be objected for the reason of failing to show every feature of the invention specified in the claims. See the drawing objection above.

#### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is 571-272-7675.

The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JHN  
March 16, 2006



Jimmy H. Nguyen  
Primary Examiner  
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